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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
09/130,998	08/07/98	STERN	M	15818-005000

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EXAMINER	
MEINECKE DIAZ,S	
ART UNIT	**PAPER NUMBER**
2765	21

DATE MAILED: 08/09/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary	Application No. 09/130,998	Applicant(s) Stern
	Examiner Susanna Meinecke-Díaz	Group Art Unit 2765

☒ Responsive to communication(s) filed on *May 19, 2000*.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-7, 9-14, and 16-27* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-7, 9-14, and 16-27* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *20*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Response to Amendment

1. This office action is responsive to the Applicant's preliminary amendment filed on May 19, 2000.

Claims 21-27 have been added.

Claims 1-7, 9-14, and 16-27 are currently pending.

2. The previous 112, second paragraph rejections have been withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-7, 9, 11, 16-23, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 (lines 4-5): It is not clear what is meant by selecting a distance "based on the duration of short term memory." This makes the limitation "said distance being based on the duration of short term memory" so vague and indefinite that it will be ignored for examination purposes.

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Claim 2 (line 2): It is not clear what is meant by "quantifying multiple times." What is being quantified? For examination purposes, it will be assumed that any sort of information used to establish statistical data is quantified.

Claim 9 (lines 6-9): It is not clear what is meant by "distance being said sites of said subset being established to *minimize displacement* of the perceivable stimulus associated with the at least one of said plurality of different products from the at least one of said plurality of differing products." For examination purposes, it will be assumed that said limitation implies that the sites have at least some minimal distance between them so that a person can differentiate each site as a separate site.

Claim 11 (line 2): It is not clear what is meant by "quantifying said multiple times." What is being quantified? For examination purposes, it will be assumed that any sort of information used to establish statistical data is quantified.

Claims 16-20, 25: Claims 16-20 and 25 are written in an incorrect computer program product format. It should be noted that code (i.e., a computer software program) does not do anything per se. Instead, it is the code stored on a computer readable medium that, when executed, instructs the computer to perform various functions. The following claim is a generic example of a proper computer program product claim:

> A computer program product embodied on a computer-readable medium and comprising code that, when executed, causes a computer to perform the following:
>
> Function A

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Function B
Function C, etc...

Claim 17 (line 2): It is not clear what is meant by "quantifying said multiple times." What is being quantified? For examination purposes, it will be assumed that any sort of information used to establish statistical data is quantified.

Claim 21 (line 2): The phrase "to maximize association of said stimulus with said product" is vague and indefinite. It is not clear how one determines at which point said association has been maximized. For examination purposes, this limitation will be interpreted as any sort of product association which attracts the attention of a customer.

Claim 22 (line 2): The phrase "to maximize association of said stimulus with said product" is vague and indefinite. It is not clear how one determines at which point said association has been maximized. For examination purposes, this limitation will be interpreted as any sort of product association which attracts the attention of a customer.

Claims 3-7, 23, and 25 are rejected for being dependent from rejected claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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6. Claims 16-20 and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 16-20 and 25 merely recite a computer program pro se; therefore, they are deemed non-statutory.

Appropriate correction is required.

Response to Arguments

7. Applicant's arguments with respect to claims 1-7, 9-14, and 16-27 have been considered but are moot in view of the new ground(s) of rejection.

ART REJECTION #1

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 1-6, 9-13, 16-19, and 21-27 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kaplan (U.S. Patent No. 5,963,916).

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As per claims 12 and 18, it should be noted that a subgroup of products corresponding to a particular date range is inherently associated with a preview history (Fig. 42), a "Top 10" or "Top 20" search (Fig. 8f), a search for "New Releases by Genre" (Fig. 8G), etc.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 7, 14, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan (U.S. Patent No. 5,963,916) as applied to claims 3, 13, and 19 (respectively) above.

Kaplan discloses a web site server which is "able to service a plurality of kiosks across the country or across the world" (col. 9, lines 29-30). Kaplan also discloses the "decompression of audio information to the subscriber" (col. 6, lines 11-12); however, Kaplan fails to explicitly disclose the compression and distribution of its distribution files to its sites via satellite. Official notice is taken that satellite communications are old and well-known in the art. As a matter of fact, satellite communications are commonly used to transmit Internet information "across the world." It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to enable Kaplan's invention to utilize satellite communications to distribute

compressed distribution files to its respective sites in order to facilitate quick and efficient global communications.

ART REJECTION #2

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

13. Claims 1-7, 9-12, 16-18, 21, 26, and 27 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Doerr et al. (U.S. Patent No. 5,949,411).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bernard et al. (U.S. Patent No. 5,918,213) disclose a remote product previewing system similar to that being claimed by the Applicant.

Kaplan (U.S. Patent No. 5,237,157) discloses a point-of-sale/kiosk product previewing system, which is similar to the invention being claimed by the Applicant.

The excerpt from PRN's web site (http://www.prn.com) is believed to correspond to the Applicant's disclosure of a version(s) of the claimed invention released to the public.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna Meinecke-Díaz whose telephone number is (703) 305-1337. The examiner can normally be reached Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann, can be reached at (703) 308-7791.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

SMD
July 17, 2000

ERIC W. STAMBER
PRIMARY EXAMINER